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April 21, 2004

**SMART & BIGGAR**

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Application No. : 2,436,872  
Owner : SHANAHAN, MICHAEL E.  
Title : METHODS AND APPARATUSES FOR PROGRAMMING  
USER-DEFINED INFORMATION INTO ELECTRONIC DEVICES -  
Classification : H04M-1/247  
Your File No. : 50320-1  
Examiner : S.Chhim

YOU ARE HEREBY NOTIFIED OF A REQUISITION BY THE EXAMINER IN ACCORDANCE WITH SUBSECTION 30(2) OF THE *PATENT RULES*. IN ORDER TO AVOID ABANDONMENT UNDER PARAGRAPH 73(1)(A) OF THE *PATENT ACT*, A WRITTEN REPLY MUST BE RECEIVED WITHIN 6 MONTHS AFTER THE ABOVE DATE.

This application has been examined taking into account the:

Description, as originally filed;

Claims, as originally filed;

Drawings, as originally filed.

This application has been examined taking into account applicant's correspondence received in this office on January 22, 2004.

The number of claims in this application is 239.

The examiner has identified the following defects in the application:

The claims are directed to the following categories of subject matter:

**Group A** - Claims 1-182 are directed to a wireless telephone;

**Group B** - Claims 183-200 are directed to a system for providing a video file;

**Group C** - Claims 201-209 and 230-239 are directed to an Internet site; and

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**Group D** - 210-229 are directed to a system for providing a polyphonic audio file.

The claims must be limited to one invention only as set out in Section 36 of the *Patent Act*.

Please note that the definition of when an application does not claim more than one invention found in Section 36 of the *Patent Act*, is not different from or additional to PCT Rule 13.1. Therefore the requirements under section 36 of the *Patent Act* are compliant with Article 27(1) of the PCT.

A search of the prior art has revealed the following:

Reference Applied:

European Patent Office Application

851,649

July 1, 1998

H04M-1/72

Armanto et al.

Armanto et al. disclose a programming of a telephone's ringing tone.

Claims 10, 44, 105, 141 and 159 do not comply with Section 28.3 of the *Patent Act*. The subject matter of these claims would have been obvious on the claim date to a person skilled in the art or science to which they pertain having regard to Armanto et al..

These claims are obvious, because Armanto et al. teaches a method, wherein a ringing tone is stored in a memory and reproduced by means of sound reproduction means as a response to an incoming call, characterised in that the ringing tone is modified into characters and sent to the telephone as characters with a ringing tone identifier. The features defined in the above claims are similar to those claimed in the Armanto et al.'s reference, namely the step of providing the user-defined audio file, and the step of enabling a user to program a portion of the audio file into the telephone.

Therefore, these claims do not comply with Section 28.3 of the *Patent Act*.

Claims 201-209 and 230-239 are directed to non-statutory subject matter, and are outside the definition of invention in Section 2 of the *Patent Act*, because they claim an Internet site using obviously a program software. A database of video or audio files is not a feature of an apparatus claim.

Claims 2, 12, 64, 107, 117, 128, 161 and 207 are ambiguous and do not comply with Subsection 27(4) of the *Patent Act*. The words "MPEG, MP3, WAV, PCM, MDI, JPEG, DVD, AVI and GIF" should be fully spelled, and not in their abbreviated forms, when using in these dependent and independent claims.

The subject matter of this application is outside the definition of invention in Section 2 of the *Patent Act*, because it is merely directed to a scheme of using a program software.

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In accordance with Subsection 81(2) of the Patent Rules, all documents referred to in the description of an application must be available to the public. Reference to the document on page 1, line 8 must be deleted or replaced by its corresponding patent or publication number.

Applicant is requested to replace the present drawings by formal drawings.

In view of the foregoing defects, the applicant is requisitioned, under Subsection 30(2) of the Patent Rules, to amend the application in order to comply with the Patent Act and the Patent Rules or to provide arguments as to why the application does comply.

Under Section 29 of the *Patent Rules*, applicant is requisitioned to provide an identification of any prior art cited in respect of the United States and European Patent Office applications describing the same invention on behalf of the applicant, or on behalf of any other person claiming under an inventor named in the present application, and the patent numbers, if granted. Amendment to avoid references cited abroad may expedite the prosecution. In accordance with Subsection 29(3) of the *Patent Rules*, if the particulars are not available to the applicant, the reason why must be stated.

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